

21



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,297	12/19/2000	David L. Hecht	07447.0006	3320

7590 03/16/2005

Daniel B. Curtis
PATENT DOCUMENTATION CENTER
XEROX CORPORATION
100 Clinton Ave. S., Xerox Sq. 20th Floor
Rochester, NY 14644

EXAMINER

KIM, CHONG R

ART UNIT PAPER NUMBER

2623

DATE MAILED: 03/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/739,297

Applicant(s)

HECHT ET AL.

Examiner

Charles Kim

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 9-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7 is/are rejected.
- 7) ☒ Claim(s) 4-6 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 11, 2004 has been entered.

Response to Amendment and Arguments

2. Applicant's amendment filed on May 11, 2004 has been entered and made of record.

3. In view of the abandonment of application number 09/737,869, the double patenting rejection is withdrawn.

4. Applicant's arguments, see pages 4-6, filed May 11, 2004, with respect to the rejection(s) of claim(s) 1-8 under 35 USC 103(a) as being unpatentable over the combination of Hecht et al and Mowry have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Petrie, U.S. Patent No. 5,611,575. Petrie discloses an embedded data code on a substrate, comprising periodic tiles (72), each tile comprising a predefined code area having a code pattern common to other tiles (col. 7, lines 54-67), and a predefined occlusion area not necessary for decoding the code pattern, the predefined occlusion area having the same location and shape in the periodic tiles (col. 10, line 65-col. 11, line 12. Note that the fourteen glyphs in the upper

Art Unit: 2623

most row of glyphs in the tile include “ordinary user data” which is not necessary for decoding the code pattern).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Petrie, U.S. Patent No. 5,611,575 (“Petrie”).

Referring to claim 1, Petrie discloses an embedded data code on a substrate, comprising periodic tiles (72), each tile comprising:

- a. a predefined code area having a code pattern common to other tiles (col. 7, lines 54-67)
- b. a predefined occlusion area not necessary for decoding the code pattern (col. 10, line 65-col. 11, line 12. Note that the fourteen glyphs in the upper most row of glyphs in the tile include “ordinary user data” which is not necessary for decoding the code pattern).

Referring to claim 2, Petrie further discloses that each tile comprises glyphs (col. 7, lines 54-67).

Referring to claim 3, Petrie further discloses that the occlusion comprises a second code pattern (col. 11, lines 7-12).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Petrie, U.S. Patent No. 5,611,575 ("Petrie") and Hecht et al., U.S. Patent No. 6,000,621 ("Hecht").

Referring to claim 7, Petrie does not explicitly disclose that the occlusions are contiguous for occlusion strips spanning across tile boundaries. However, this feature was exceedingly well known in the art. For example, Hecht discloses embedded data code on a substrate comprising occlusions that are contiguous for occlusion strips spanning across tile boundaries (figure 6).

Petrie and Hecht are combinable because they are both concerned with embedding data code on a substrate. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the occlusions of Petrie so that they are contiguous for occlusion strips spanning across tile boundaries, as taught by Hecht. The suggestion/motivation for doing so would have been enhance the flexibility of the data encoded substrate by providing multiple code pattern configurations. Therefore, it would have been obvious to combine Petrie with Hecht to obtain the invention as specified in claim 7.

Art Unit: 2623

Allowable Subject Matter

7. Claims 4-6, 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kim whose telephone number is 703-306-4038. The examiner can normally be reached on Mon thru Thurs 8:30am to 6pm and alternating Fri 9:30am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OK
ck

March 10, 2005


Jon Chang
Primary Examiner